

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

REMARKS

Claims 1, 2, 5-9, 11-20 and 24-27 are in the application. Claims 1, 2, 5, 6, 11-14, 16, 20, and 25 are currently amended; claims 9, 24, 26, and 27 were previously presented; claims 3, 4, 10, and 21-23 are cancelled; and claims 7, 8, 15, and 17-19 remain unchanged from the original versions thereof. Claims 1, 16, and 20 are the independent claims herein.

No new matter is added to the application as a result of the presently presented Response. Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 USC § 112, 1st Paragraph

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Office Action maintains this rejection on the basis that the following terms are unclear to the Examiner: digital information, structuring with a processor the information received relating to details of the legal action; the predetermined criteria; the scaled value or scale alphanumeric value indicative of an amount of risk associated with the legal action; how the scaled numeric value or scaled alphanumeric value is based upon a portion of the structured information; how a suggested action is generated; and what is an aggregate level of risk. The Examiner is reminded that the applicable standard regarding 35 USC 112, 1st paragraph, is whether the specification enables one skilled in the art to practice the claimed invention. Applicant submits and maintains that each of the foregoing terms would be understood by those skilled in the relevant art, particularly as the terms are discussed in the context of the specification. Applicant emphasizes that each of the terms described as being unclear by the Examiner are used in a manner consistent with the pertinent arts, and not created anew by Applicant.

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

Furthermore, Applicant reserves the right to submit an affidavit that each of the terms used (not created by Applicant) and described as being unclear by the Examiner would be understood and enabling by one skilled in the art to make and use the invention.

Notwithstanding Applicant's arguments regarding the enablement of the specification, Applicant has currently amended claims 1, 16, and 20 to clarify that which Applicant claims as the invention. For example, the claim language of claims 1, 16, and 20 now more closely tracks the language of the specification. The Examiner is directed to refer to FIG. 3 and the discussion of same in the specification. Applicant notes that claim 1 is worded similar to the concise and unambiguous language of the flow diagram of FIG. 3 and the corresponding discussion thereof. The Examiner's attention is particularly directed to operations 310-313 of FIG. 3 and the discussion of same in paragraphs [0042] – [0048] of the published application.

Applicant respectfully submits that the various terms recited in the claims, which are alleged as being unclear by the Examiner, are used in clear and explicit examples of implementations of the claimed invention. For example, Applicant provides examples of received information related to a legal action that may impact risk associated with a legal action. (See paragraphs [0045]- [0046]) Applicant further provides exemplary weights, that is, actual numbers, that correlate to the exemplary scaled numerical or alphanumerical values. (See paragraph [0046]) Applicant further discusses a risk quotient in the context of a range of relative values. (See paragraph [0047]) Thus, it is clear that the specification provides explicit and numerous articulations of the terms recited in the specification and claims, in the context of, for example, implementations, illustrative drawings (e.g., systems, flow diagrams, etc.), and claims.

It is further emphasized that those skilled in the relevant arts would in fact understand what is meant by such terms as: digital information; structuring, using a processor, information relating to received information relating details of a legal action; a scaled numeric value or scaled alphanumeric value indicative of an amount of risk associated with a legal action; how the scaled numeric value or scaled alphanumeric

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

value is based, at least in part, on the structure information; how an action may be suggested in response to the scaled numeric value or scaled alphanumeric value, and what an aggregate level of risk means.

Moreover, those skilled in the art would find the specification enabling to the extent to make or use the claimed Invention without undue experimentation. Applicant reminds the Examiner that it is not a requirement of 35 USC 112, 1st paragraph that the specification eliminate all experimentation, ordinary experimentation commensurate with the art is acceptable. It is sufficient that the specification enable one skilled in the art to make or use the invention without having to resort to undue experimentation.

The Office Action restates, in part, Applicant's exemplary calculation of a scaled numeric or scaled alphanumeric value as disclosed at paragraph [0045] of the specification. However, the Office Action omits much of the contextual details of the disclosure. Applicant respectfully suggests that the Examiner read the disclosure as a whole, including the contextual descriptions therein, as opposed to parsing the specification apart as reproduced in the Office Action. Applicant further submits that one skilled in the art reading the specification as a whole (as disclosed), would be enabled to practice and make the claimed invention, particularly in light of the explicit, concise, and unambiguous examples disclosed.

Regarding the Office Action's Response to Arguments, the Examiner takes issue with rebuttal statements provided in the prior Response. In particular, the Examiner cites the prior statement that "a person practicing the present invention is free to generate a value via objective or subjective means" and "A risk assessment factor can be anything that is important to the client and relates to the client's status as party to a litigation or an *amicus curiae*." Based on these statements, the Examiner concludes that the disclosure is entirely subjective and incomplete and only provides a general description of old and well known approaches to common analysis of risk.

Contrary to the totality of Applicant's arguments of record, the specification, and the claims, the Examiner has apparently chosen to disregard the objective basis for

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

determining the disclosed and claimed numeric values. Applicant directs the Examiner's attention to paragraphs [0043] – [0055] where numerous examples and types of objective criteria are disclosed. The Examiner may also reference claim 1 wherein Applicant claims the scaled numeric or alphanumeric value is based, at least in part, on the structured information (i.e., objective, concrete information).

It is also noted the Examiner appears to confuse the requirements of 35 USC 112, 1st paragraph with other aspects of 35 USC (e.g., novelty, 35 USC 102).

Further, it is not seen why Applicant is required to disclose with greater specificity how one would exactly quantify a numeric value or alphanumeric value. Applicant has clearly articulated a number of factors that may impact each value throughout the specification. In view of a complete absence of any cited and relied upon prior art reference requiring greater specificity of the disclosed scaled numeric and scaled alphanumeric values, Applicant maintains that the specification is in fact enabling.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 5-9, 11-20, and 24-27 under 35 USC 112, 1st paragraph.

Claim Rejections Under 35 USC § 112, 2nd Paragraph

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In particular, the Examiner specifically takes issue with the recitation of "wherein the scaled value or scaled alphanumeric value is based upon a *portion* of the structured information". Applicant has amended claim 1 to clarify that "the scaled value or scaled alphanumeric value is based upon at least a portion of the structured information". That is, the scaled numeric value or the scaled alphanumeric value is based on at least a part (i.e., a portion) of structured information, not necessarily all of the structured information.

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

Further, the Examiner questions how the weighted criteria is determined. The scaled numeric value or scaled alphanumeric values are generated using a computer processor, as supported by the specification, at least at paragraph [0046]. Furthermore, the specification provides additional details regarding the factors that may impact the scaled numeric value or scaled alphanumeric values and the assignment of the values. In light of any relevant cited art, the need to amend the claims to include greater specificity is not seen at this time.

Finally, Applicant respectfully submits that those skilled in the art are fully aware that computer processors are routinely implemented to perform operations to structure, manipulate, and otherwise process data and data to provide, for example, data and information in accordance with one or more data structures, and to generate numeric calculations.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 5-9, 11-20, and 24-27 under 35 USC 112, 2nd paragraph.

Claim Rejections Under 35 USC § 101

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner has chosen, to the exclusion of the disclosure as a whole and the claim language in particular, to view the claims as abstract idea. The Examiner concludes as much on the basis that the claimed methods do not yield concrete results. Applicant respectfully disagrees with the Examiner's characterization of the claimed invention.

For example, Applicant clearly claims the scaled numeric value or scaled alphanumeric value is based on structured information (the structured information relating to details of a legal action and structured by a computer processor) and indicative of an amount of risk associated with the legal action. Clearly, information

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

structured by a computer processor is tangible and concrete. The scaled numeric value or scaled alphanumeric value assigned based on the tangible and concrete structured information is also a tangible and concrete result. Surely, it is clear that the claimed numeric and alphanumeric values generated by a computer-implemented method are not mere abstractions of ideas.

The Examiner further questions the effectiveness of the claimed invention. Applicant respectfully submits that the claimed invention may be used in assessing and managing risk related to a legal action. It is further submitted that the variety and diversity risks associated with a legal action may be great, as explained in the specification. Accordingly, the claims are commensurate in scope with the problem addressed by the claims. Applicant submits that it is improper for the Examiner to reject the claims on the basis that the methods may not satisfy some objective provided solely by the Examiner (i.e., being predictive), an not required by U.S. patent law. Applicant notes that the claims do not recite that the claimed methods are "predictive".

Applicant maintains that the pending claims are directed towards patentable subject matter under 35 USC 101. Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 5-9, 11-20, and 24-27 under 35 USC 101.

Claim Rejections Under 35 USC § 103(a)

Claims 1-2, 4-9, 11-22, and 24-27 are rejected as being unpatentable over Heckman et al., U.S. Patent No. 5,875,431 (hereinafter, Heckman) in view of Halligan et al., U.S. Publication No. 2002/0077941 (hereinafter, Halligan). This rejection is respectfully traversed.

Regarding claims 1, 16, and 20, Heckman is directed to a closed loop legal strategic planning system for outlining objectives and tasks and their associated timing. Three closed loop control systems a) monitor legal costs, b) monitor attainment of objectives and c) control deliverables derived from completion of tasks (col. 1 lines 21-33). Heckman is directed to maximizing the likelihood of a desired

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

legal outcome in connection with a legal action and control costs (col. 4 lines 63-68). Essentially, Heckman describes case management software. A fundamental aspect of the invention without which implementation of the invention would be impracticable is directed to a strategic plan cost management strategy and bench marking elements (col. 15 40-49).

The system of Heckman receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome feedback data from which future litigation/legal templates might be drawn (col. 16 lines 18- 21). Heckman describes how the three kinds of data can be applied to attain the objectives of the Heckman system (monitor legal costs, monitor attainment of objectives and control deliverables derived from completion of tasks).

The Office Action admits, *inter alia*, that Heckman does not describe or imply the generation of a scaled numerical value or a scaled alphanumeric value indicative of an amount of risk associated with a legal action.

The Office Action cites and relies upon Halligan to disclose structuring, with a processor, received information relating to a pending legal action; generation of a scaled numerical value or a scaled alphanumeric value indicative of an amount of risk associated with a legal action; a processor operatively attached to a computer storage wherein the scaled numeric value or scaled alphanumeric value is based on a portion of the structured information; and generating a report comprising the scaled numeric value or the scaled alphanumeric value and the portion of the structured information related to a legal action.

However, it is noted that Halligan is directed to methods and a system in which selected data and other information about a trade secret is collected and characterized and entered into a specialized database with certain unique functions. The system includes a method and apparatus for protecting a trade secret. The method includes the steps of applying a plurality of generally accepted legal criteria to the content of the

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

trade secret, assigning a value under each criterion and generating one or more metrics from the assigned values through the use of logical and mathematical processes, thereby allowing the comparison of results with predetermined threshold values. (paragraph [0020]) As Halligan discloses, "Trade secret is a recognized intellectual property right under United States laws, and also under the laws of many foreign countries. The other intellectual property protection provided to ideas is patent protection. Patent protection, unlike trade secret protection, requires disclosure." (emphasis added, paragraph [003]) That is, trade secrets are a form of intellectual property, just as patents, trademarks, and copyrights are forms of intellectual property.

Each of the different types of intellectual property relate to and provide different types of protective rights. The rights protected by each category of intellectual property are not the same as or suggestive of a legal action (e.g., court proceeding or action involving adverse parties). A trade secret is no more a legal action than is a patent. While a trade secret and a patent may be at issue in a legal action, neither a trade secret nor a patent is explicitly, implicitly, or inherently part of or related to any legal action.

Applicant respectfully submits that Halligan does not disclose or suggest a legal action. Halligan at most discloses a legal reviewer to review and add comments regarding the information descriptive of a trade secret (paragraph [0022]), and legal criteria related to factors or tests applied to ascertain if information pertains to a trade secret as described in the U.S., Section 757 of the First Restatement of Torts. (paragraph [0009]) Halligan is not concerned with a managing or assessing a risk related to a legal action. Halligan is instead directed to the documentation, analysis, auditing, accounting, protection, registration, and verification of trade secrets.

Thus, it is clear that Halligan does not in fact disclose that for which it is cited and relied upon for disclosing in support of the rejection under 35 USC 103(a). Accordingly, even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the admitted failings of Heckman and the demonstrated failings of

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 5-9, 11-15, 17-19, and 24-27 depend from claims 1, 16, and 20. Therefore, it is further submitted that all of the pending claims 1, 2, 5-9, 11-20, and 24-27 are patentable over Heckman and Halligan under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 5-9, 11-20, and 24-27 under 35 USC 103(a).

Application Serial No.: 09/825,470
Amendment and Response to January 7, 2005 Non-Final Office Action

CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

July 7, 2005

Date



Randolph P. Calhoune
Registration No. 45,371
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-5985